

Response

Applicant: Stuart D. Asakawa et al.

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

REMARKS

The following remarks are made in response to the Office Action mailed August 24, 2004, in which claims 1-20 were rejected. With this Response, no claims have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102

Claims 1, 3, 4, 9-12, 15 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robinson et al. (U.S. Patent No. 5,850,584).

Robinson et al. is alleged to teach the invention as presented in independent claims 1, 9, and 19. Independent claims 1 and 19 specify that the printer operational resources comprise **core** printer operational resources and **enhanced** printer operational resources, and that the payment transaction includes a charge calculated as a function of said **enhanced** printer operational resource request. Independent claim 9 similarly divides printer operational resources into a first resource set and a second resource set, and initiates a payment transaction when the requested printer operational resource is a member of said second set, and wherein the payment transaction includes a charge calculated as a function of the resource request.

Contrary to the characterization of the reference set forth in the Office Action, Applicants respectfully submit that Robinson et al. fails to teach, or suggest the subject matter of independent claims 1, 9 and 19. In particular, Robinson et al. fails to distinguish between **core** printer operational resources and **enhanced** printer operational resources, and specifically **fails to teach or suggest a charge calculated as a function of the request for the use or right of use of an “enhanced printer operational resource,”** as opposed to a charge for the printed product generally.

Robinson et al. teaches that the user selects an image of a desired quality, and costs are then calculated based on the amount of materials consumed for that job (col. 6, lines 34-36), the paper used for the job (col. 7, lines 47-49), and the type of finishing coating (col. 7, lines 62-67).. Various methods for determining the amount of materials consumed are described (col. 6, line 42 through col. 7, line 46). In Robinson et al., there is not a division or distinction between core operational resources and enhanced operational resources, and in

Response

Applicant: Stuart D. Asakawa et al.

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

particular, **the cost is not calculated as a function of an enhanced operational resource request.** As seen by the cost curve set forth in Figure 2 of Robinson et al., costs fall along a continuous curve, without a cost distinction between core and enhanced operational resources. Even if In Robinson et al. is interpreted as having both core and enhanced operational resources (for example, black and white output vs. color output), the cost in Robinson et al. is calculated as a function of *all* operational resource requests (i.e., the amount of materials consumed, the paper used, and the type of finishing coatings), not just those resource requests utilizing what may be characterized as “enhanced” operational resources.

For at least the reasons set forth above, Robinson et al. fails to anticipate the subject matter of independent claims 1, 9 and 19. Accordingly, withdrawal of the rejection of independent claims 1, 9 and 19 under 35 U.S.C. § 102(b) is respectfully requested.

Each of dependent claims 3, 4, 10-12 and 15 depend from one of independent claims 1 and 9, which are in allowable condition for at least the reasons set forth above. Therefore, dependent claims 3, 4, 10-12 and 15 are also in allowable condition, and withdrawal of the rejections of those claims under 35 U.S.C. § 102(b) is respectfully requested.

Claim Rejections under 35 U.S.C. § 103

The Office Action presents a variety of 35 U.S.C. § 103(a) rejections of the dependent claims, and in each case relies on Robinson et al.:

- claims 2 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Pierce (U.S. Patent No. 6,202,057);
- claims 5 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Maruta et al. (U.S. Patent No. 6,064,838);
- claims 6 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Hayashi (U.S. Patent No. 6,375,297);
- claims 7, 8, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson in view of Nocker (U.S. Patent No. 6,236,486); and
- claims 14 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Freeman (U.S. Patent No. 6,134,557).

Response

Applicant: Stuart D. Asakawa et al.

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

Each of claims 2, 5-8, 13, 14, 16-18 and 20 depend, either directly or indirectly, from one of independent claims 1, 9 and 19, which are in allowable condition for at least the reasons set forth above with respect to the rejections under 35 U.S.C. § 102(b). Therefore, dependent claims 2, 5-8, 13, 14, 16-18 and 20 are also in allowable condition at least by reason of their dependency from an allowable claim, and withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

Response

Applicant: Stuart D. Asakawa et al.

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (280) 396-3958, or Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Stuart D. Asakawa et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2000
Facsimile: (612) 573-2005

Date: Nov 22, 2005
MBM:dmd:imv

Matthew B. McNutt
Matthew B. McNutt
Reg. No. 39,766

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of November, 2005.

By Matthew B. McNutt
Name: